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EXAMINER

CHEVALIER, ALICIA ANN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1772

DATE MAILED: 02/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/846,133

Applicant(s)

BROWN, WARD THOMAS

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-17 is/are pending in the application.
- 4a) Of the above claim(s) 9-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

RESPONSE TO AMENDMENT

Note to Applicant: The Response filed on December 7, 2002 of record in paper #6 mentions on page 3 that "Applicants are herein amending claim 1 and 5, and canceling claim 8." The amendment to claim 1 and the canceling of claim 8 are found within the response. However, the response does not contain amendments to claim 5. It is assumed since there is no amendment to claim 5 within the response, this is a typographical error.

WITHDRAWN REJECTIONS

1. The objections to the specification of record in paper #5, pages 2-5, paragraph #2 have been withdrawn due to Applicant's amendments in paper #6.
2. The 35 U.S.C. §112 rejections of record in paper #5, pages 5-6, paragraph #4 have been withdrawn due to Applicant's arguments in paper #6.
3. The 35 U.S.C. §102 rejection of claims 1 and 6 as anticipated by Phillips (5,977,263) of record in paper #5, page 7, paragraph #7 have been withdrawn due to Applicant's amendments in paper #6.
4. The 35 U.S.C. §102 rejection of claims 1-6 as anticipated by Klein et al. (5,882,771) of record in paper #5, page 7, paragraph #8 have been withdrawn due to Applicant's amendments in paper #6.
5. The 35 U.S.C. §102/103 rejection of claims 2-5 as anticipated by or over Phillips (5,977,263) of record in paper #5, pages 8-9, paragraph #10 have been withdrawn due to Applicant's amendments in paper #6.

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6. The 35 U.S.C. §103 rejection of claim 7 over Bailey (4,950,525), Phillips (5,977,263) or Klein et al. (5,882,771) in view of Photo et al. (5,514,441) of record in paper #5, page 9, paragraph #12 have been withdrawn due to Applicant's amendments in paper #6.

REJECTIONS REPEATED

7. The 35 U.S.C. §102 rejection of claims 1, 6 and 8 as anticipated by Bailey (4,950,525) is repeated for reasons previously of record in paper #5, pages 6-7, paragraph #6.

8. The 35 U.S.C. §102/103 rejection of claims 2-5 as anticipated by or over Bailey (4,950,525) is repeated for reasons previously of record in paper #5, page 8, paragraph #9.

9. The 35 U.S.C. §103 rejection of previous claim 8 (now claim 1) over Phillips (5,977,263) or Klein et al. (5,882,771) in view of Bailey (4,950,525) is repeated for reasons previously of record in paper #5, pages 9-10, paragraph #13.

NEW REJECTIONS

10. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 103

11. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips (5,977,263) in view of Bailey (4,950,525) previously of record in paper #5, pages 9-10, paragraph #13.

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Phillips discloses a graphic article imparted with weather protection and wear resistance which are applied to outdoor surfaces (col. 1, lines 33-42). The article comprises a binder layer with a pigment layer, a layer of glass microspheres, and a transparent cover film (col. 5, line 55 to col. 6, line 9 and figure 1). The sheeting may further comprise ultraviolet light absorbers (col. 10, lines 30-35).

Although Phillips does not explicitly teach the limitations binder polymer glass transition temperature or the percent visible light transmission of the coating, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. transparent polymers) used to produce the composite. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594.

Phillips discloses all the limitations of the instant invention except the composite is used on pavement.

Bailey discloses a retroreflective sheeting used as a marker on the pavement (col. 9, lines 30-33).

It would have been obvious to one of ordinary skill at the time of the invention to use Phillips' sheet as a marker on the pavement as disclosed by Bailey since retroreflective sheeting are good pavement markers due to their high visibility.

12. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein et al. (5,882,771) in view of Bailey (4,950,525) previously of record in paper #5, pages 9-10, paragraph #13.

Klein discloses a retroreflective sheeting comprising an adhesive a spacing layer, a layer of glass beads, a layer of bead bong, a primer layer, a top film, and another primer layer (figure 4

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and col. 4, lines 5-31). The optical primer layers are light transmissible materials which transmits more than 90% of the incident light at a given wavelength (col. 4, lines 25-31). The bead bond layer has a glass transition temperature of less than about 0 degrees Celsius (col. 2, lines 25-29). Additionally, weathering additives such as UV absorbers may be added (col. 8, line 48). Furthermore, dyes or pigments may be added to any of the layers ion the sheeting (col. 11, lines 54-59).

Klein discloses all the limitations of the instant invention except the composite is used on pavement.

Bailey discloses a retroreflective sheeting used as a marker on the pavement (col. 9, lines 30-33).

It would have been obvious to one of ordinary skill at the time of the invention to use Klein's sheet as a maker on the pavement as disclosed by Bailey since retroreflective sheeting are good pavement markers due to their high visibility.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips (5,977,263) in view of Bailey (4,950,525) as applied to claims 1-6 above, and further in view of Jacobs et al. (5,941,655).

Phillips and Bailey disclose all the limitations of the invention except for the composite comprising an absorber such as talc.

Jacobs discloses a glass bead retroreflective article comprising a base sheet constructed of a polymer and a particulate inorganic filler such as talc (col. 8, lines 34-64).

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It would have been obvious to one of ordinary skill to add talc as an inorganic filler to binder layer of Phillips as taught by Jacobs when used as a pavement marker because the filler would add stiffness and hardness and decrease the cost of the polymer.

14. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klein et al. (5,882,771) in view of Bailey (4,950,525) as applied to claims 1-6 above, and further in view of Jacobs et al. (5,941,655).

Klein and Bailey disclose all the limitations of the invention except for the composite comprising an absorber such as talc.

Jacobs discloses a glass bead retroreflective article comprising a base sheet constructed of a polymer and a particulate inorganic filler such as talc (col. 8, lines 34-64).

It would have been obvious to one of ordinary skill to add talc as an inorganic filler to binder layer of Klein as taught by Jacobs when used as a pavement marker because the filler would add stiffness and hardness and decrease the cost of the polymer.

15. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey (4,950,525) in view of Jacobs et al. (5,941,655).

Bailey discloses all the limitations of the invention except for the composite comprising an absorber such as talc.

Jacobs discloses a glass bead retroreflective article comprising a base sheet constructed of a polymer and a particulate inorganic filler such as talc (col. 8, lines 34-64).

It would have been obvious to one of ordinary skill to add talc as an inorganic filler to binder layer of Bailey as taught by Jacobs when used as a pavement marker because the filler would add stiffness and hardness and decrease the cost of the polymer.

ANSWERS TO APPLICANT'S ARGUMENTS

16. Applicant's arguments filed in paper #6 regarding the objections to the specification and the 35 U.S.C. §112 rejections of record have been considered but are moot since the rejections have been withdrawn.

17. Applicant's arguments regarding the 35 U.S.C. §102 rejection anticipated by Bailey (4,950,525) of record have been carefully considered but are deemed unpersuasive.

Applicant argues that Bailey does not disclose a composite on a surface of a substrate, "wherein said surface of said substrate is a road surface and said composite is a traffic marking." Applicant specifically argues that Bailey does not disclose the applicant of his sheeting directly to a road surface, instead it applied to base plate and then applied to the road surface. As applicant points out Bailey discloses the "sheeting of the invention is especially adapted to pavement markings, in which the sheeting is typically adhered to a base support that adapted to be adhered to a paved surface" (column 10, lines 34-37). Claim 1 uses the term "comprises" which is open language. Even though Bailey includes additional structure, such as a base plate, not required by applicant's invention, it must be noted that Bailey discloses the invention as claimed. The fact that it discloses additional structure not claimed is irrelevant, since applicant uses open claim language.

Applicant further argues that Bailey does not disclose the application of his sheeting in the form of a liquid, when used for pavement marking and other methods of applying and making applicant's invention. First, these method limitations which applicant is arguing are not state in the claims. Second, the method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which

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reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the applicant's argument that "applicant's first coating composition and clear coating composition are allowed to dry, or are caused to dry only after applicant's composite has been applied to the road sure is a method of production and therefore does not determine the patentability of the product itself.

Applicant further argues that "applicant's ability achieve the desired retroreflectance with fewer coating layers than Bailey's sheeting layers constitutes an improvement in the art."

Applicant has failed to clearly point out how the claim language differentiates the claimed invention from the prior art of record in order to achieve this improvement. The fact remains that it is irrelevant that Bailey discloses additional structure not claimed, since applicant uses open claim language, applicant is not claiming method limitations in claim 1, and the method of forming the product is not germane to the issue of patentability of the product itself.

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18. Applicant's arguments regarding the Phillips (5,977,263) reference of record have been carefully considered but are deemed unpersuasive.

Applicant argues that Phillips does not disclose all the limitations of the instant invention because Phillips' graphic article is a solid preformed sheet, unlike Applicant's composite, which is not a preformed sheet. As stated above, the method of forming the product is not germane to the issue of patentability of the product itself.

Applicant argues that Philips' graphic article imparts weather protection and wear resistance to the outdoor surface on which the article is applied, which applicant is "not at all concerned about." Even though Philips recognizes other potential benefits and/or adds additional structure to obtain these improvements in which applicant is not concerned with and not required by applicant's invention, it must be noted that the combination of Philips and Bailey discloses the invention as claimer. The fact that it discloses additional structure or benefits not claimed is irrelevant.

19. Applicant's arguments regarding the Klein (5,882,771) reference of record have been carefully considered but are deemed unpersuasive.

Applicant argues that Klein does not meet all the limitations of the instant claimed invention because (1) the formation of Klein's retroreflective sheeting requires the application of heat for purposes of curing, and (2) Klein's retroreflective sheeting is a perform, unlike Applicant's composite, which is not a preformed sheet. Applicant has failed to clearly point out how the claim language differentiates the claimed invention from the prior art. As stated above, the method of forming the product is not germane to the issue of patentability of the product itself. Applicant's argument that Klein does not disclose the applicant's invention because

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applicant's invention is made without the application of heat, is a method of forming and not a limitation in the claims.

20. Applicant's arguments regarding the 102/103 rejections of record have been carefully considered but are deemed unpersuasive.

Applicant argues in pages 11-14 regarding the 102/103 rejections of Bailey and Phillip are based on applicant's opinion that these references do not meet the limitations of claim 1 and method in which applicant makes their marker but does not claim. These arguments have already been addressed above.

21. Applicant's arguments regarding the 103 rejections of claim 7 of record have been carefully considered but are moot due to the new grounds of rejection.

22. Applicant's arguments regarding the 103 rejections of Phillips or Klein in view of Bailey of record have been carefully considered but are deemed unpersuasive.

Applicant argues that Bailey does not disclose application of his sheeting directly to a road surface. Applicant's arguments regarding the Bailey reference have already been addressed above.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

2/13/03



HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

2/19/03